

**REMARKS**

**INTRODUCTION:**

In accordance with the claims listed above, no claims have been amended, added or cancelled.

Claims 1-4, 6, 7, and 9-13 are pending in the present application. Claims 1, 3, 6, 9 and 11 are the independent claims. Reconsideration of the claims is respectfully requested.

**REJECTIONS UNDER 35 USC 103:**

Claims 1-4, 6, 7, 9, and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Application No. 2003/0023761 by Jeansonne et al. ("Jeansonne") in view of U.S. Application No. 2003/0126492 by Cavin ("Cavin"). Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Jeansonne in view of Cavin and further in view of U.S. Publication No. 2005/0032516 by Marchevsky (Marchevsky) and further in view of U.S. Patent No. 6,816,067 to Patton ("Patton"). Claims 12 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Jeansonne in view of Cavin and further in view of Patton. All rejections are respectfully traversed.

Independent claim 1 recites at least the following:

"a controller controlling the power supplying part to supply power to ... the BIOS memory to execute the network accessing routine, according to the selection to display the wireless accessibility through the selection part while the power to the portable computer is turned off...".

Jeansonne, Cavin, Marchevsky, and Patton, taken separately or in combination, fail to suggest or disclose at least all of the above-recited features of independent claim 1. The Response to Arguments section of the Office Action, on page 2, asserts the following regarding the above-recited features:

"Jeansonne clearly discloses a wireless accessing routine for determining a wireless accessibility based on a wireless signal (see abstract). Therefore, Cavin only needs to teach or suggest a wireless accessing routine stored in the BIOS memory. Indeed, Cavin clearly discloses BIOS/firmware layer (read as BIOS memory) to execute wireless communications (read as wireless accessing routine) (see [0037]). Therefore, a wireless accessing routine is stored in the BIOS memory and inherently power is

supplied to execute the routine."

Applicant respectfully disagrees with the above analysis from the Office Action.

The Office Action notes at page 5, second paragraph, that Jeansonne "fails to disclose a BIOS memory storing a network accessing routine determining the wireless accessibility based on the wireless signal received by the wireless communicating part and supplying power directly to the BIOS memory." However, the Office Action looks to modify Jeansonne with Cavin and asserts, at page 2, that Cavin clearly discloses BIOS/firmware layer (read as BIOS memory) to execute wireless communications (read as wireless accessing routine).

Even assuming for the sake of argument that Cavin describes a BIOS/firmware layer to execute wireless communications, Cavin still fails to suggest or disclose all of the above-recited features of claim 1. In fact, Cavin would have no reason to suggest a controller controlling the power supplying part to supply power to ... the BIOS memory ... according to the selection to display the wireless accessibility through the selection part while the power to the portable computer is turned off..." because the BIOS of Cavin would function appropriately according to conventional power-on techniques. In other words, the Office Action provides no reason why the BIOS of Cavin would require power when the computer system of Cavin is turned off.

In fact, the Office Action appears to acknowledge that neither Jeansonne nor Cavin suggest the above-recited features. Instead the Office Action seeks to rely on a theory of inherency, stating that "a wireless accessing routine is stored in the BIOS memory and inherently power is supplied to execute the routine."

Applicant disagrees that a theory of inherency can be relied upon to suggest the supply of power to the BIOS memory as claimed in claim 1 because such features would not be inherent to all devices. As stated above, a conventional device such as that described in Cavin would have no reason to provide power to the BIOS when the computer system of Cavin is turned off.

Notwithstanding the foregoing, Applicant asserts that the current Office Action fails to provide the objective evidence and technical reasoning necessary to support a conclusion of inherency.

MPEP 2112 IV states the following regarding a rejection based on inherency:

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Citing*

*Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).*

If an assertion of inherency is to be relied upon in any future Office Action, Applicant respectfully requests the rejection provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied reference, as required by MPEP 2112 IV.

Further, Marchevsky and Patton fail to compensate for the asserted deficiencies of Jeansonne and Cavin.

Accordingly, Applicants respectfully submit that claim 1 patentably distinguishes over Jeansonne, Cavin, Marchevsky, and Patton, and should be allowable for at least the above-mentioned reasons. Since similar features recited by independent claims 3, 6, 9 and 11, with potentially differing scope and breadth, are not suggested or disclosed by Jeansonne, Cavin, Marchevsky, and Patton, the rejection should be withdrawn and claims 3 6, 9 and 11 also allowed.

Further, claims 2, 4, 6, 7, 9, 10, 12 and 13, variously depend from independent claims 1 3, 6 and 9, and should be allowable for at least the same reasons as claims 1 3, 6, and 9, as well as for the additional features recited therein.

Independent claim 11 recites at least the following:

illuminating, while the network accessing routine is being executed, a display part in an illumination mode that differs from an illumination mode when it is determined whether a wireless network is accessible;

Jeansonne, Cavin, Marchevsky, and Patton, taken separately or in combination, fail to suggest or disclose at least all of the above-recited features of independent claim 11.

The Office Action notes, at page 11, that neither Jeansonne nor Cavin describe all of the features recited above. However, the Office Action proposes to modify Jeansonne and Cavin with Marchevsky, asserting that Marchevsky describes a tri-colored LED that illuminates yellow to indicate that a wireless network may be present and that the tri-colored LED may be interpreted as "illuminating, while the network accessing routine is being executed."

Applicant respectfully disagrees with this assertion because indicating that a wireless network is present is not the same as indicating that a network accessing routine is being

executed. To the contrary, a network may be indicated as present in many instances in which a network accessing routine would not be executing.

Patton fails to compensate for the deficiencies of Jeanssonne, Cavin and Marchevsky.

Accordingly, Applicants respectfully submit that claim 11 patentably distinguishes over Jeanssonne, Cavin, Marchevsky, and Patton, and should be allowable.

No Reason to Combine

Applicant respectfully submits that at least the rejection of claims 11-13 fails to establish a prima facie case of obviousness. To establish a prima facie case of obviousness: 1) there must be some suggestion or motivation to combine the references, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art; 2) there must be a reasonable expectation of success; and 3) the references must either teach or suggest all the claim limitations or the Office must provide a rationale as to why the differences between the claimed invention and the prior art are obvious. MPEP 2141.

Here, no citation to the prior art has been offered as providing a suggestion or reason to modify Jeanssonne, Cavin, Marchevsky and Patton, nor does the Office Action provide evidence demonstrating an implicit motivation to modify the documents. In *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 127 S.Ct 1727, 167 LEd2d 705 (U.S. 2007), the U.S. Supreme Court held that in determining obviousness, it is necessary "to determine whether there was an apparent reason to combine the known elements in the fashion claimed" *KSR*, slip op. 14, 82 USPQ2d at 1396. Further, "there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR* at 1396, quoting *In re Kahn*. The reasoning provided in the Office Action for combining Jeanssonne, Cavin, and Marchevsky with Patton states:

"It would have been obvious to a person ordinary skill in the art at the time the invention was made to modify the teachings of Jeanssonne, Cavin and Marchevsky with the teachings of Patton in order to provide an audible indication to a user when a wireless network is detected."

Applicant asserts that the cited rationale for combining Jeanssonne, Cavin, and Marchevsky with Patton is merely a conclusion and therefore fails to meet the standard articulated by the Supreme Court in *KSR International Co. v. Teleflex Inc.* *KSR*, as cited above, emphasizes that a prima facie obviousness case cannot be met merely by citing the different elements and then concluding that the same would have been obvious. In fact, the reasoning

provided above is clearly a conclusion, and even somewhat circular in nature, in that it cites almost verbatim the language of the rejected claim as the reason to combine.

As further stated by the Supreme Court in *KSR*:

"Often it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of the demands known to the design community or present in the market place; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit." *Id.*

Accordingly, Applicant asserts the Office Action fails to demonstrate that one skilled in the art would have had a reason to combine the teachings of Jeansonne, Cavin, and Marchevsky with Patton, and consequently the rejection of claims 11-13 under 103(a) is improper.

#### CONCLUSION:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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